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|-----------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------------|------------------------|
| APPLICATION NO.                                                                               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
| 10/786,404                                                                                    | 02/24/2004  | Hiroaki Shibasaki    | B-5387 621729-9               | 4084                   |
| 7590<br>LADAS & PARRY<br>Suite #2100<br>5670 Wilshire Boulevard<br>Los Angeles, CA 90036-5679 |             | 04/01/2009           | EXAMINER<br>POLLACK, MELVIN H |                        |
|                                                                                               |             |                      | ART UNIT<br>2445              | PAPER NUMBER<br>PAPER  |
|                                                                                               |             |                      | MAIL DATE<br>04/01/2009       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                         |
|------------------------------|--------------------------------------|-----------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/786,404 | <b>Applicant(s)</b><br>SHIBASAKI ET AL. |
|                              | <b>Examiner</b><br>MELVIN H. POLLACK | <b>Art Unit</b><br>2445                 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 15 January 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

|                                                                                                             |                                                                                         |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/06/08)<br>Paper No(s)/Mail Date: _____ | 6) <input checked="" type="checkbox"/> Other: <i>see attached office action</i>         |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 January 2009 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.
3. The new title is accepted.
4. The art rejections have been withdrawn in favor of new art.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 9-14, 17-19, 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Risan et al. (7,316,033).

7. For claims 1, 12, 17, 23, 25, Risan teaches a system and an information-recording apparatus (abstract) that is capable of accessing an information-providing apparatus via a network (col. 1, line 1 – col. 5, line 10; col. 35, line 60 – col. 36, line 15), and comprising:

- a. an ID-information-acquisition device (Fig. 4, #451) which acquires ID information (col. 17, lines 5 -15) that corresponds to a media data recorded on a first recording medium (Fig. 2, #251 (remote hard drive); alternatively col. 5, line 60 – col. 6, line 15 and col. 19, lines 5-25 (CD/DVD Player));
- b. a protection-information-recognition device (Fig. 4, #300 and 450) adapted to recognize whether a first recording medium has protection information used for protecting copyright by preventing recording of said media data recorded on said first recording medium from being recorded onto a second recording medium other than said first recording medium (col. 20, lines 25 – 40; col. 20, line 55 – col. 21, line 5);
- c. an ID-information-sending device (Fig. 3, #303-305) which sends ID-information corresponding to said media data to an information-providing apparatus via said network in a case where it is recognized that said first recording medium has the protection information related to said media data (col. 28, lines 55-60 for remote hard drive; col. 31, lines 50-65 for CD player input);
- d. a corresponding-information-receiving device which receives corresponding content information related to said media data that is sent from said information-providing apparatus via said network according to said ID information (col. 28, line 65 – col. 29, line 10); and

- e. an information-recording device which records said corresponding content information related to said media data onto said second recording medium instead of recording said media data onto said second recording medium upon receipt of said corresponding content information related to said media data by the information-recording apparatus (col. 15, lines 60 – 67; col. 18, lines 15 – 30; col. 31, line 65 – col. 32, line 10; col. 32, line 60 – col. 33, line 20).
2. For claim 2, Risan teaches that when recording media data onto said second recording medium, said information-recording apparatus records said corresponding content information related to said media data on to said other recording medium instead of said media data by way of said ID-information-sending device and said corresponding-information-receiving device when it is not possible to record said media data from said first recording medium to said second recording medium regardless of whether or not there is said protection information (col. 18, lines 15 – 30).
3. For claims 3, 13, 18, 24, Risan teaches that said information-recording apparatus further comprises:

  - a. a trial-information-receiving device which receives trial information that is related to said media data and that is sent from said information-providing apparatus according to said ID information via said network (col. 15, line 55 – col. 16, line 5);
  - b. an information-reproduction device which reproduces said received trial information (Fig. 3, #300); and
  - c. a corresponding-information-request device which prompts the user to request said corresponding content information related to said media data after said trial

information has been reproduced by said information-reproduction device (col. 26, line 30 – col. 27, line 40); and wherein said information-providing apparatus further comprises:

- d. a trial-information-acquisition device which acquires said trial information based on said ID information (col. 28, lines 5 - 30); and
- e. a trial-information-sending device which sends said trial information to said information- recording apparatus via said network (col. 26, line 30 – col. 27, line 40); and
- f. wherein said corresponding-information-sending device sends said corresponding content information related to said media data to said information-recording apparatus only when there was a request from said information-recording apparatus for said corresponding content information related to said media data (col. 26, line 30 – col. 27, line 40).

20. For claims 4, 14, 19, Risan teaches that said information- recording apparatus further comprises:

- a. a user-information-acquisition device which acquires user information that is set for each apparatus or for each said recording medium (Figs. 2 and 4); and
- b. a user-information-sending device which sends said acquired user information to said information-providing apparatus via said network (Fig. 3); and
- c. wherein said information-providing apparatus further comprises a user-information- receiving device for receiving said user information sent from said information-recording apparatus (col. 15, line 30 - col. 16, line 5); and

- d. wherein said corresponding-information-sending device determines based on said user information whether or not access is improper access, and when it determines that access is improper access, it does not send said corresponding content information related to said media data to said information-recording apparatus (col. 16, line 5 – col. 18, line 50).
- 21. For claims 9, 22, Risan teaches that said first recording medium is a removable-type recording medium that is owned by said user (col. 5, line 45 – col. 6, line 25).
- 22. For claim 10, Risan teaches that said information-recording device correlates said corresponding content information related to said media data with said ID information and records them on said second recording medium (col. 9, line 15 - col. 10, line 10).
- 23. For claim 11, Risan teaches that said ID- information-sending device determines whether or not said corresponding content information related to said media data correlated with said ID information is recorded on said second recording medium, and when it is determined that it is recorded, it does not send said ID information (col. 20, lines 60 - 67).
- 24. For claim 26, Risan teaches that the media data is music data (col. 7, lines 10-20) and the first recording medium is a compact disc (col. 7, lines 65 – 67).

*Claim Rejections - 35 USC § 103*

- 25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 5-8, 15, 16, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risan as applied to claims 1, 12, and 17 above, and further in view of Strietzel (6,950,804).

27. For claims 5, 15, 20, Risan does not expressly disclose the use of cost information.

Strietzel teaches a method and system (abstract) of using cost gathering techniques in copyright-protected information (col. 1, line 1 - col. 3, line 65) that said information-recording apparatus further comprises a cost-information-receiving device which receives the cost corresponding to said corresponding content information related to said media data via said network (col. 3, line 65 – col. 4, line 35); and wherein said information-providing apparatus further comprises:

- a. a cost-information-acquisition device (Fig. 1, #110) which acquires said cost information (col. 6, line 40 – col. 7, line 25); and
- b. a cost-information-sending device which sends said acquired cost information to said information-recording apparatus via said network (col. 7, line 55 – col. 9, line 25).

28. At the time the invention was made, one of ordinary skill in the art would have added Strietzel's purchase information to Risan in order to ensure information sharing of legitimately owned media while protecting the interests of copyright holders (col. 2, lines 20 – 40).

29. For claims 6, 16, 21, Streitzel teaches that said information- providing apparatus further comprises a user-information-management device (Fig. 1, #108) which manages said user information; and wherein said cost-information-acquisition device acquires said cost information based on said user information managed by said user-information-management device (col. 7, line 55 – col. 9, line 25).

30. For claim 7, Streitzel teaches that said information-recording apparatus further comprises a cost-information-supply device which supplies the user with said cost information; and wherein

said corresponding-information-request device prompts the user to request said corresponding content information related to said media data after said cost information has been supplied to the user by said cost-information-supply device (col. 5, lines 60 – 65; col. 8, line 35 – col. 9, line 25).

31. For claim 8, Streitzel teaches that teaches that said cost information is information showing the bill for said corresponding content information related to said media data (col. 16, lines 5 - 20).

***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melvin H Pollack/  
Examiner, Art Unit 2445  
26 March 2009